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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,943	08/04/2003	Gregory Winfield Gorman	408392	5211

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EXAMINER

AHMAD, NASSER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,943

Applicant(s)

GORMAN, GREGORY WINFIELD

Examiner

Nasser Ahmad

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 28-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-17, 19 and 28-34 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 18 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Rejection Maintained

1. claims 1-3, 5,12 and 14 are rejected under 35 USC 102(b) as being anticipated by Wilson for reasons of record in the last Office Action mailed on March 14, 2005.

Response to Arguments

2. Applicant's arguments filed May 24, 2005 have been fully considered but they are not persuasive.

Applicant argues that Wilson does not recite a pavement tape. This is not found to be convincing because Wilson clearly teaches that the tape that is applied to a floor, which includes pavement. As seen in the drawings, Wilson's tape is a continuous elongated flexible tape body, with front and rear surface that do not overlap an end of the tape body.

Applicant's argument that "Foot and motor traffic would crush the cardboard tent" of Wilson is not deemed to be persuasive because the claimed invention does not include said phrase and cannot be read thereinto for the purpose of avoiding the applied prior art. In view of various citations from the specification by the applicant, applicant is informed that the specification cannot be read into the claims for the purpose of avoiding the prior art.

Applicant argues that the claimed tape is a flat bottomed structure. However, said feature could not be located in the claims and cannot be read thereinto for the purpose of avoiding the applied prior art.

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In response to applicant's argument at Wilson fails to teach the front face bearing at least one symbol, it is noted that Wilson clearly teaches the print being "caution: electrical wires" on its front surface and as acknowledged by the applicant in the remark section, page-11, third paragraph.

Therefore, in the absence of any evidence to the contrary it remains the examiner's position that the claimed invention is anticipated by the prior art of record discussed above.

Rejections Withdrawn

3. Claims 1-5, 7-8, 11-14, 16-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Townsend (WO-02/38870 A1) has been withdrawn in view of the amendment filed on May 24, 2005.

4. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Townsend has been withdrawn in view of the amendment.

Response to Arguments

5. Applicant's arguments with respect to claims 1-19 and newly submitted claims 28-35 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-19 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 12 recites that "wherein the front and rear faces do not overlap an end of the continuous elongated flexible tape body". The phrase underlined is found to be a negative limitation and, as such is deemed to be new matter for lack of express support in the specification.

This phrase is found to be a new matter phrase.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-19 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 12, the phrase "wherein the front and rear faces to don not overlap...tape body" is found to be indefinite and confusing. It is unclear as to what is referred by said phrase. In is unclear as to how can the two faces not overlap an end of the tape.

Claim 30, the "release tape" is found to be confusing. Could it be the release liner?

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-5, 7-8, 11-14, 16-17, 19, 28-32 and 34 are rejected under 35

U.S.C. 102(e) as being anticipated by Bastiaens (6514655).

Bastiaens relates to a pavement tape (col. 5, lines 27-28) comprising a continuous (col. 2, line 42) elongated flexible tape body (18) comprising front and rear surface, said front surface comprising at least one symbol (24) that conveys information.

The reference is silent with respect to the phrase “ the front and rear faces do not overlap an end of the tape body” and hence, the two faces do not overlap.

As shown in figure-2, the rear face comprises an adhesive (36) covered with a release liner (37). The front face is provided with the information print and is covered by a transfer tape (7) that is understood to be releasably bonded to said front face. The symbols include commercial information (col. 5, line 35). The layer (30) is part of the symbol-containing tape and is reflective.

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The intended use phrases such as "for conveying information", "configured to be affixed", etc. have not been given any patentable weight because said phrase are directed to an intended use of the claimed product tape.

Regarding claims 11 and 19, the railing is not found to be of positive limitation as it is attached to the intend use pavement and not part of the claimed tape. Hence, it has not been given any patentable weight.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6, 15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiaens.

Bastiaens, as discussed above, fails to teach that the tape is 6-12 inches wide. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tape to have width of 6-12 inches for having the space to present visible printed information thereon, since it has been held that where the general condition of a claim is disclosed in the prior art, discovering the optimum or workable ranges involve only routine skill in the art. *In re Aller*, 105 USPQ 233. In this case, the prior art tape is also a pavement tape having the structure as claimed.

Allowable Subject Matter

13. Claims 9-10, 18 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art uncovered so far fails to teach the presence of least one symbol formed as a perforation or a flexible mask tape having at least one symbol formed as a perforation extending from its front face to its rear face, and the tape is bonded to the front face of the pavement tape.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

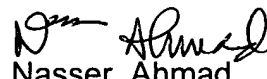
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772
8/7/05

N. Ahmad.
August 7, 2005.